

## REMARKS

Claims 2-34 are pending. Claims 6-34 have been withdrawn. Claims 2-5 are currently under examination. Claims 2-5 have been amended. Claim 34 has been canceled. Support for the amendments can be found throughout the specification and the claims as filed. Accordingly, these amendments do not raise an issue of new matter and entry thereof is respectfully requested.

### Regarding the Declaration

In the Office Action, it is indicated that the oath or declaration is defective. Submitted herewith is a copy of the supplemental Declaration filed in parent application 09/394,142, in compliance with 37 C.F.R. § 1.67(a).

### Objections to the Specification

The Office Action indicates that trademarks are not properly demarcated. The specification has been amended on pages 37-38 to recite “TM” for the detergent “Tween-20.” The abstract page has also been amended as requested by the Examiner to recite “Abstract.” Accordingly, Applicants respectfully request that the objections to the specification be withdrawn.

### Objection to the Claims

The Office Action indicates that claims 2-5 have been objected to for being directed to subject matter of non-elected inventions. Claims 2-5 have been amended to reflect the elected invention. Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

### Rejections Under 35 U.S.C. § 112, Second Paragraph

The rejection of claims 2-5 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Applicants respectfully submit that the claims are clear and definite.

In the Office Action, claims 2 and 3 are indicated to be unclear for the phrase “having a nucleotide sequence corresponding to [...].” Without addressing the merits of the rejection,

claims 2 and 3 have been amended to delete this phrase. Accordingly, Applicants respectfully submit that this rejection has been rendered moot and request that this rejection be withdrawn.

The Office Action additionally indicates that claims 3 and 5 are considered to be indefinite for the phrase “a functionally active BAG family protein selected from the group [...]” because it allegedly cannot be determined to which proteins the claims are directed. Without addressing the merits of the rejection, claims 3 and 5 have been amended to delete this phrase. Accordingly, Applicants respectfully submit that this rejection has been rendered moot and request that this rejection be withdrawn.

The Office Action also indicates that claim 4 is considered to be indefinite for the phrase “selected from the group [...].” Applicants respectfully submit that this rejection has been rendered moot by the cancellation of this phrase and respectfully request that this rejection be withdrawn.

#### Rejections Under 35 U.S.C. § 112, First Paragraph

The rejection of claims 2, 3 and 5 under 35 U.S.C. § 112, first paragraph, as allegedly lacking written description is respectfully traversed. Applicants respectfully submit that the specification provides sufficient description and guidance for the claimed nucleic acid molecules.

The Office Action indicates that the claims are considered to be drawn to a genus of structurally and/or functionally varying nucleic acid molecules comprising a nucleotide sequence that “corresponds to” or is complementary to at least 20 nucleotides from SEQ ID NO:1 and has been interpreted to not necessarily be the same as any 20 contiguous nucleotides contained in SEQ ID NO:1. Applicants respectfully point out that the phrase “corresponding to or complementary to at least 20 nucleotides” is no longer recited in the claims and, accordingly, the issues discussed in the Office Action relating to this phrase have been rendered moot. Applicants respectfully submit that the specification provides sufficient description and guidance for the claimed nucleic acid molecules. Accordingly, Applicants respectfully request that this rejection be withdrawn.

The rejection of claims 2, 3 and 5 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement is respectfully traversed. Applicants respectfully submit that the

specification provides sufficient description and guidance to enable the claimed nucleic acid molecules.

The Office Action indicates that the claims encompass a genus of nucleic acid molecules having widely varying structures and functions, as explained under the written description rejection. As discussed above, the claims have been amended to delete the phrase “corresponding to or complementary to at least 20 nucleotides.” Therefore, the issues discussed in the Office Action relating to this phrase have been rendered moot. Applicants respectfully submit that the specification provides sufficient description to enable the claimed nucleic acid molecules. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### Rejections Under 35 U.S.C. § 102

The rejection of claims 2, 3 and 5 under 35 U.S.C. § 102(b) as allegedly anticipated by Boehringer Mannheim Biochemicals, 1994 Catalog, page 93 (herein after the “Boehringer catalog”), is respectfully traversed. Applicants respectfully submit that the claims are novel over the Boehringer catalog.

The Office Action asserts that the Boehringer catalog describes a kit containing a collection of random primers that are fully complementary to any 20 nucleotides of SEQ ID NO:1. Applicants respectfully submit that the Boehringer et al. catalog does not teach the claimed nucleic molecules of claims 2, 3 or 5, as amended. Accordingly, Applicants respectfully request that this rejection be withdrawn.

The rejection of claims 2, 3 and 5 under 35 U.S.C. § 102(e) as allegedly anticipated by Fodor et al., U.S. publication 2001/0053519, is respectfully traversed. Applicants respectfully submit that the claims are novel over Fodor et al.

The Office Action asserts that Fodor et al. describes n-mer arrays that include sequences that correspond to or are complementary to at least 20 nucleotides of SEQ ID NO:1. Applicants respectfully submit that Fodor et al. does not teach the claimed nucleic molecules of claims 2, 3 or 5, as amended. Accordingly, Applicants respectfully request that this rejection be withdrawn.

The rejection of claims 2-5 under 35 U.S.C. § 102(b) as allegedly anticipated by Takayama et al., Genomics 35:494-498 (1996), is respectfully traversed. Applicants respectfully submit that the claimed nucleic acid molecules are novel over Takayama et al.

Applicants respectfully submit that Takayama et al. does not teach the nucleic acid molecules of claims 2-5, as amended. Absent such a teaching, Applicants respectfully submit that Takayama et al. cannot anticipate the claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### Double Patenting

The rejection of claims 2-5 under the judicially created doctrine of obviousness-type double patenting as allegedly obvious over claims 1 and 2 of U.S. Patent No. 6,696,558 is respectfully traversed. Applicants respectfully request that this double patenting rejection be held in abeyance until there is an indication of allowable subject matter.

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

/Deborah L. Cadena/

Deborah L. Cadena  
Registration No. 44,048

4370 La Jolla Village Drive, Suite 700  
San Diego, CA 92122  
Phone: 858.535.9001 DLC:llf  
Facsimile: 858.597.1585  
**Date: October 16, 2007**

**Please recognize our Customer No. 41552  
as our correspondence address.**